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10/642,902	08/19/2003	Daniel Mark Abraham		3195

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10/31/2008

EXAMINER

HENRY, RODNEY M

ART UNIT	PAPER NUMBER
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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/642,902	Applicant(s) ABRAHAM, DANIEL MARK	
	Examiner RODNEY M. HENRY	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action on the merits. The Examiner acknowledges receipt of the remarks dated August 25, 2008. Claims 3-22 are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 3-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 3-22, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent ¹ and Federal Circuit decisions a §101 process must

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. ²

The independent claim is directed towards steps of “displaying”, “printing”, “identifying”, “generating”, “tracking”, and “repeating”. Since the claims are directed to a process without including another statutory class of invention (manufacture, machine,

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advance. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 9-12, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin IV et al. (2002/0049816), in view of Paul et al. (US 7,240,843).

As per claim 3:

Costin IV et al. discloses an electronic process which allows printable coupons to be provided online through a Website for fundraising by a Cause, said Cause being one of a non-profit organization, a charity organization, or a school, the process comprising the steps of:

displaying to a Supporter, incentives for consumer goods of Sponsors identified for a selected Cause;

printing a coupon with a household ID number of a selected incentive, selected by said Supporter (see FIG. 7 for the incentives and the print icon for printing the coupon (savings) associated with the user's account);

generating a revenue share shared with the selected Cause and the Website, after redemption of said printed coupon wherein that portion of the revenue share generated for the Cause is fundraising revenue (see paragraph [0082]).

Costin IV et al. does not disclose identifying the selected Cause via the household ID number associated said printed coupon.

However, Paul et al. discloses identifying the selected Cause via the household ID number associated said printed coupon (see col 4 line 9 and FIG. 1 for customer ID and optional extension codes such as Cause in the barcode).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to add customer ID and optional extension codes such as Cause in the barcode to the system of Costin IV et al. in order to enhance the tracking system associated with the fundraising activity.

As per claims 9, 18:

Costin IV et al. does not discloses maintaining in a database information and reporting regarding all departments, incentives or remuneration, links, Supporter accounts and redemption information on the printed coupons.

However Paul et al. discloses maintaining in a database information and reporting regarding all departments, incentives or remuneration, links, Supporter accounts and redemption information on the printed coupons (See col 8, lines 40-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add maintaining in a database information and reporting regarding all departments, incentives or remuneration, links, Supporter accounts and redemption information on the printed coupons to the system of Costin IV et al. in order to promote proper tracking of coupons and the fundraising system.

As per claims 10, 19:

Paul et al. discloses that the household ID number is part of a UCC/EAN extended 128 barcode (see col 4, lines 5-10).

As per claims 11, 20:

Costin IV et al. discloses the origin of the coupon by zip (See page 3, paragraph [0037], which discusses the regional information entered by the participant is a postal ZIP code, and the software first processes the ZIP code to determine a geographical region and then processes the geographical region information to determine which coupons are available),

Costin IV et al. does not disclose:
printing on said coupon said UCC/EAN extended 128 barcode;
information related to a Sponsor's brand name; an item name; a value of the coupon;
disclaimers and modifiers for the coupon; and product images

Paul discloses printing on said coupon said UCC/EAN extended 128 barcode;

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information related to a Sponsor's brand name; an item name; a value of the coupon; disclaimers and modifiers for the coupon; and product images (See FIG. 1 and col 4, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add UCC/EAN extended 128 barcode to the system of Costin IV et al. in order to promote high density barcode usage.

As per claims 12, 22:

Costin IV et al. discloses receiving from the Sponsor redemption revenue reimbursement for the Website (see paragraph [0082]).

4. Claims 4-6, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin IV et al. (2002/0049816), in view of Paul et al. (US 7,240,843), and further in view of Messer et al. (US 2004/0230491).

As per claim 4:

Costin IV et al. does not disclose logging into a database the household ID number of the printed coupon; and identifying in the database the Supporter, the selected Cause and a Sponsor of the printed coupon.

However Messer et al. discloses logging into a database the household ID number of the printed coupon; and identifying in the database the Supporter, the selected Cause and a Sponsor of the printed coupon (see paragraph [0025] for identification of the user (supporter), and tracking (identifying and analysis) and paragraph [0042] for the database).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to add logging into a database the household ID number of the printed coupon; and identifying in the database the Supporter, the selected Cause and a Sponsor of the printed coupon to the system of Costin IV et al. in order to enhance the tracking system associated with the fundraising activity.

As per claims 5, 15:

Costin IV et al. does not disclose tracking redemption activity of said printed coupon via household ID number with respect to the Supporter, the selected Cause and the Sponsor wherein the step of generating the revenue share is in response to the redemption activity tracking.

However, Messer discloses tracking redemption activity of said printed coupon via household ID number with respect to the Supporter, the selected Cause and the Sponsor wherein the step of generating the revenue share is in response to the redemption activity tracking (see paragraph [0025]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was add tracking redemption activity of said printed coupon via household ID number with respect to the Supporter, the selected Cause and the Sponsor wherein the step of generating the revenue share is in response to the redemption activity tracking to the system of Costin IV et al. in order to compensate the charitable organizations.

As per claims 6, 16:

Costin IV et al. does not disclose prior to the generating step, redeeming the printed coupon.

However, Messer discloses prior to the generating step, redeeming the printed coupon (see paragraph [0025]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add prior to the generating step, redeeming the printed coupon to the system of Costin IV et al. in order to ensure the participant makes the transaction first.

As per claim 13:

Costin IV et al. discloses an electronic process which allows printable coupons to be provided online through a Website for fundraising by Causes, each Cause being one of a non-profit organization, a charity organization, or a school, the process comprising the steps of:

(a) displaying online, to a Supporter, incentives for consumer goods of Sponsors identified for a selected Cause (see FIG. 7 for the incentives and the print icon for printing the coupon (savings) associated with the user's account);

(b) printing by said Supporter while online at least one selectable printable coupon with an indigenous tracking code having a household ID number (see FIG. 7 for the incentives and the print icon for printing the coupon (savings) associated with the user's account);

(d) in response to step (c.), generating a revenue share shared with the selected Cause and the Website, wherein that portion of the revenue share generated for the selected Cause is fundraising revenue (see paragraph [0082]).

(e) repeating steps (a) – (d) for a plurality of Supporters (See FIG. 1 FIG. 2 and discussions on a-d).

Costin IV et al. does not disclose

(c) tracking redemption activity of the printed coupon to identify the selected Cause via the household ID number

However, Messer discloses tracking redemption activity of the printed coupon to identify the selected Cause via the household ID number (See paragraph [0025]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to add tracking redemption activity of the printed coupon to identify the selected Cause via the household ID number to the system of Costin IV et al. in order to fund the charitable organizations.

As per claim 14:

Costin IV et al. does not disclose

(f) logging into a database the household ID number of said indigenous tracking code of the printed coupon; and

(g) identifying in the database the Supporter, the selected Cause and a Sponsor of the printed coupon.

However Messer et al. discloses logging into a database the household ID number of the printed coupon; and identifying in the database the Supporter, the

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selected Cause and a Sponsor of the printed coupon (see paragraph [0025] for identification of the user (supporter), and tracking (identifying and analysis) and paragraph [0042] for the database).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to add logging into a database the household ID number of the printed coupon; and identifying in the database the Supporter, the selected Cause and a Sponsor of the printed coupon to the system of Costin IV et al. in order to enhance the tracking system associated with the fundraising activity

5. Claims 7, 8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin IV et al. (2002/0049816), in view of Messer (US 2004/0230491), and DeLapa et al. (5,822,735), and Narayan et al. (2002/0138348), and further in view of Humble (US 4,949,256).

As per claim 7:

Costin IV et al. does not disclose the redeeming step includes:

processing the coupon by a redemption facility wherein said redemption facility process includes:

receiving from a retailer the redeemed coupon;

identifying the Sponsor associated the redeemed coupon; and

generating duplicate redemption files, wherein a first redemption file is for the Sponsor and a second redemption file is for the Website.

Narayan et al. teaches an electronic coupon system having means for:

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processing the coupon by a redemption facility (See page 5, paragraph [0137], which discusses the redemption facility being a retail merchant) wherein said redemption facility process includes:

receiving from a retailer the redeemed coupon (See page 5, paragraph [0137], which discusses the retailer redeeming the coupon and presenting it to the manufacturer to collect its charges for handling the transaction);

identifying the Sponsor associated the redeemed coupon (See page 5, paragraph [0137], which discusses the first issuer of the coupon as the ultimate redeemer of the coupon).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add redeeming steps to the system of Costin IV et al., in order to compensate the Website and other retailers.

Humble further discloses duplicate redemption files, wherein a first redemption file is for the Sponsor and a second redemption file is for the Website (See the Abstract, which discusses a first file for all redeemable encoded coupons issued by all manufacturers (Sponsor) participating in the network, and a second file for all coupons redeemed by each retailer (Website) participating in the network).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add duplicate redemption files to the system of Costin IV et al. in order to provide accurate records for compensating the Website and for keeping the Sponsors informed of product sales via coupon usage.

As per claim 8:

Costin IV et al. does not disclose sending redemption reimbursement from the Sponsor for the redemption facility.

However De Lapa et al discloses sending redemption reimbursement from the Sponsor for the redemption facility (See col 5, lines 30-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add redemption reimbursement from the Sponsor for the redemption facility to the system of Costin IV et al. in order to reimburse the retailer more rapidly.

As per claim 17:

Costin IV et al. does not disclose the redeeming step includes: processing the coupon by a redemption facility wherein said redemption facility process includes:

- (i) receiving from a retailer the redeemed coupon;
- (ii) identifying the Sponsor associated the redeemed coupon; and
- (iii) generating duplicate redemption files, wherein a first redemption file is for the Sponsor and a second redemption file is for the Website.

Narayan et al. teaches an electronic coupon system having means for: processing the coupon by a redemption facility (See page 5, paragraph [0137], which discusses the redemption facility being a retail merchant) wherein said redemption facility process includes:

(i) receiving from a retailer the redeemed coupon (See page 5, paragraph [0137], which discusses the retailer redeeming the coupon and presenting it to the manufacturer to collect its charges for handling the transaction);

(ii) identifying the Sponsor associated the redeemed coupon (See page 5, paragraph [0137], which discusses the first issuer of the coupon as the ultimate redeemer of the coupon).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add redeeming steps to the system of Costin IV et al., in order to compensate the Website and other retailers.

(iii) generating duplicate redemption files, wherein a first redemption file is for the Sponsor and a second redemption file is for the Website.

Humble further discloses generating duplicate redemption files, wherein a first redemption file is for the Sponsor and a second redemption file is for the Website (See the Abstract, which discusses a first file for all redeemable encoded coupons issued by all manufacturers (Sponsor) participating in the network, and a second file for all coupons redeemed by each retailer (Website) participating in the network).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add duplicate redemption files to the system of Costin IV et al. in order to provide accurate records for compensating the Website and for keeping the Sponsors informed of product sales via coupon usage.

As per claim 21:

Costin IV et al. discloses the step of (f) repeating steps (a) – (e) for said Causes (See page 1, paragraph [0007], which discusses the appeal of the invention to a plurality of schools).

Costin IV et al. does not disclose (b) printing a coupon with an indigenous tracking code of a selected incentive, selected by said Supporter.

De Lapa et al. discloses an indigenous tracking code of a selected incentive (See column 3, lines 41-43, which discusses coupons are printed bearing a machine readable code including a coupon identification number and a user number).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add an indigenous tracking code of a selected incentive to the system of Costin IV et al., in order to reduce or track fraudulent usage of coupons.

Response to Arguments

6. The applicant's arguments are moot in light of the new grounds of rejection above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Tuesday through Friday from 7:30 am to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000

RMH

/Arthur Duran/

Primary Examiner, Art Unit 3622